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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/699,530	10/30/2000	David Tolpin	25310-1C	7292
21186	7590	02/12/2004	EXAMINER	
SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A. P.O. BOX 2938 MINNEAPOLIS, MN 55402			TRAN, QUOC A	
			ART UNIT	PAPER NUMBER
			2176	5
DATE MAILED: 02/12/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application N .	Applicant(s)
	09/699,530	TOLPIN, DAVID
	Examiner Quoc A. Tran	Art Unit 2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 30 October 2000.
 2a) This action is **FINAL**. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-20 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-20 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>no2, 10/30/2000</u> .	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

DETAILED ACTION

1. This action is in responses to application filed 10/30/2000.
2. Claims 1-20 are currently pending in this application. Claims 1, 9, and 17 are independent claims.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention of the term '*executable instruction*', **[which is directed to the method of inserting footnotes or directed to the media?]**; Clarification and/or correction are required.
5. Claims 17-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention of the term '*executable instruction*', **[which is directed to the method of managing footnotes or directed to a unit of media?]**; Clarification and/or correction are required.

6. In regards to claims 1-8, and 17-20, because as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention of the term '*executable instruction*', *[which is directed to the method of managing footnotes or directed to a unit of media?]*; examiner interprets, as executable instruction, which is directed to the method of managing footnotes not directed to a media or unit of media.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. **Claims 1-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

As to independent claims 1, 9, and 17, the claimed invention is not tied to the technological art environment or machine. The claimed invention is not embodied on a computer readable medium, nor are the "executable instructions" explicitly recited as being carried out, or functionally tied in, to a computer environment. Therefore, the claims read on steps that could be carried out mentally and/or using paper and pencil.

As to dependent claims 2-8, 10-16 and 18-20 also is not tied to the technological art environment or machine, and are rejected under the same rationale.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. **Claims 1-6, and 9-16 are rejected under 35 U.S.C. 102(b) as being unpatentable by Chirokas et al. US No. 5,111,397 issued May 1992 (hereinafter '397)**

In regard to independent claim 1, the feature is teaches in '397 col. 1, lines 41-42, the body and footnote texts have been entered; compare with claim 1 "*receiving non footnote data body and footnote body data*", Also teaches in '397 col. 1, lines 43-44, assemble all body and footnote texts into respective pages; compare with claim 1 "*inserting the non footnote body data into one or more first locations within a media*".

Also teaches in '397 col. 1, lines 38-40, recall the body text display and continue typing further body text until the next footnote reference point is reached; compare with claim 1 "*inverting the non footnote body data to one or more second locations when the footnote body data are inserted into the media*",

Also teaches in '397 col. 1, lines 56-59, first footnote is referenced and only part of the footnote text fits on the remaining lines available on that page, it is known to continue the remaining footnote text on as many subsequent pages as needed to

complete the footnote; compare with claim 1 “restoring the non footnote body data into the first locations with the footnote body data occupying one or more of the second location”.

In regard to dependent claim 2, the feature is teaches in '397 col. 2, lines 12-14, body text is always on every page because they place a maximum line limitation on each page for footnote text; compare with claim 2 “associating a dimension with a logical unit of the media”.

In regard to dependent claim 3, the feature is teaches in '397 col. 1, lines 56-59, first footnote is referenced and only part of the footnote text fits on the remaining lines available on that page, it is known to continue the remaining footnote text on as many subsequent pages as needed to complete the footnote; compare with claim 3 “the first locations occur sequentially before the second locations within the media”.

In regard to dependent claim 4, the feature is teaches in '397 col. 2, lines 39-54, pagination/repagination utility program which produces the output pages...; compare with claim 4 “logical unit is an output page”.

In regard to dependent claim 5, the feature is teaches in '397 col. 1, lines 37-40, The operator can then recall the body text display and continue typing further body text until the next footnote reference point is reached; compare with claim 5 “continuing to insert the footnote body data to a second output page when the output page is populated and the footnote body data are not completely inserted into the media”.

In regard to dependent claim 6, the feature is teaches in '397 col. 1, lines 30-35, At the footnote reference point, a menu is called from which a footnote task is selected. This causes the display to change to a footnote text display and the operator then types in the footnote text; compare with claim 6 "*receiving a citation data associated with the non footnote body data prior to inserting the footnote body data*".

In regard to independent claim 9, incorporate substantially similar subject matter as cited in claims 1, 6, and 3; compare with claim 9: "*receiving data including non footnote data and footnote data*", "*footnote citations, and one or more footnote bodies*", "*footnote citation serially into a media*", and in further view of the following, and are similarly rejected along the same rationale;

Also teaches in '397 col. 7, lines 45-50, If there is a violation, the program proceeds...the "last good line" ... Otherwise, the program goes to ...begins other matters not relating to footnote processing. Eventually, the program returns t...where the entire process of assembling a new line of body text commences again; compare with claim 9 "*interrupting the insertion when at least one footnote citation is detected and inverting a start location and an end location associated with a unit of the media such that the end location houses the non footnote data and at least one of the footnote citations while at least one of the footnote bodies are inserted serially at a start location within the media*".

Also teaches in '397 col. 6, lines 30-40, when the flow path proceeds ...and the line being assembled does not fit on the output page, the path leads to ... "last good

line" which is the last line of body text that did not violate any rules of style. The output page then ends with the recalled "last good line." Continuing along this path results in the footnotes that were processed after the last good line to be removed from the footnote queue. Those removed footnotes are then available for inclusion in the next output page to be assembled; compare with claim 9 "*swapping the start location and the end location after inserting at least one of the footnote bodies such that the non footnote data and at least one of the footnote citations are located at the start location and at least one of the footnote bodies are located at the end location*".

In regard to dependent claim 10, the feature is teaches in '397 col. 2, lines 12-14, body text is always on every page because they place a maximum line limitation on each page for footnote text; compare with claim 10 "*the unit of the media is associated with a dimension*".

In regard to dependent claim 11, the feature is teaches in '397 col. 1, lines 48-50, all referenced footnotes fit on the bottom of an output page of the output document; compare with claim 11 "*unit of the media is a page*".

In regard to dependent claim 12, the feature is teaches in '397 col. 2, line 2, footnotes having text; compare with claim 12 "*the non footnote data includes at least one of text data, image data, audio data, and video data*".

In regard to dependent claim 13, the feature is teaches in '397 col. 6, lines 30-40, when the flow path proceeds ... and the line being assembled does not fit on the output page, the path leads to ... "last good line" which is the last line of body text that did not violate any rules of style. The output page then ends with the recalled

"last good line." Continuing along this path results in the footnotes that were processed after the last good line to be removed from the footnote queue. Those removed footnotes are then available for inclusion in the next output page to be assembled; compare with claim 13 "*managing the start and end locations within the unit of media using one or more pointers*".

In regard to dependent claim 14, the feature is teaches in '397 col. 1, lines 55-64, first footnote is referenced and only part of the footnote text fits on the remaining lines available on that page, it is known to continue the remaining footnote text on as many subsequent pages as needed to complete the footnote. If a second or additional footnote references are also on the same body text line containing the first footnote reference, the text of these other footnotes will not appear on the same page where they are referenced; compare with claim 14 "*inserting a remaining portion of at least one of the footnote bodies to a subsequent unit of the media when a space associated with the unit of media becomes fully occupied during the insertion of at least one of the footnote bodies*".

In regard to dependent claim 15, the feature is teaches in '397 col. 1, lines 53-55, there is a general rule of document style that all footnotes should appear on the same page containing the body text where they referenced; compare with claim 15 "*associating dynamically resizable geometric areas within the unit of the media to house the footnote data and the non footnote data*".

In regard to dependent claim 16, the feature is teaches in '397 col. 1, lines 48-50, all referenced footnotes fit on the bottom of an output page of the output

document (common knowledge in the art, a page's dimension is commonly in a rectangular shape); compare with claim 16 "associating dynamically resizable geometric areas *within the unit of the media to house the footnote data and the non footnote data*".

11. Claims 17-20 are rejected under 35 U.S.C. 102(b) as being unpatentable by Cuan et al. US No. 4,503,515 issued May 1985 (hereinafter '515).

In regard to independent claim 17, the feature is taught in '515 col. 2, lines 61-63, automatic system reference/footnote numbering and updating are provided in a single pass through the document; compare with claim 17 "associating an entry path for receiving footnote data with the unit of media",

Also teaches in '515 col. 1, lines 64-66, During preparation, body text is keyed to a body text frame up to a reference point, a footnote reference number is keyed, a footnote frame is called, a corresponding footnote number is keyed, text for the footnote is keyed, and then the body text frame is recalled; compare with claim 17 "associating a second path for receiving non footnote body data with the unit of media".

Also teaches in '515 col. 1, lines 38-65, input keying of the body and footnote text, operator procedure calls for causing the system to assemble the body and footnote text; compare with claim 17 "reversing a first location on the unit of media associated with the second path with an ending location. Associated with the entry path for purposes of inserting the footnote data into the unit of media".

In regard to dependent claim 18, the feature is teaches in '515 col. 2, lines 61-63, If footnotes are inserted, moved, or deleted from the assembled document, then the document must be reassembled to renumber the footnotes; compare with claim 18 "*restoring the first location associated with the second path and the ending location associated with the entry path for purposes of inserting the non footnote data body into the unit of media*".

In regard to dependent claim 19, the feature is teaches in '515 col. 15, lines 36-45, routine RSOLVE to perform the actual resolution of footnote references. Its function is to resolve each footnote reference control that the paginator encountered after adjusting the cursored body text line. It is already assumed that there is room at the bottom of the page for at least one more footnote text line and that the footnote placement is the bottom of page, not bottom of document; compare with claim 19 "*extending the entry path to a subsequent unit of media when the unit of media is full and insertion of all of the footnote data is not complete*".

In regard to dependent claim 20, the feature is teaches in '515 col. 15, lines 46-55, all of the footnotes on a page can be copied and formatted into the formatted footnote TSB (140); compare with claim 20 "*formatting the footnote data and the non footnote body data within the unit of media after insertion*".

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 7, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over '397, in view of Ferrel et al. US No. 5,860,073 issued January 1999 (hereinafter '073).

In regard to dependent claim 7, '397 does not explicitly teach, "the non footnote body data and the footnote body data are received in an extensible stylesheets language format" however '073 teaches, A style sheet, as used in Microsoft Word, is a compilation of character and paragraph styles, with each style containing properties for formatting marked text. These style sheets are associated with a particular document to define how marked characters and paragraphs are displayed to the use, see '073 col. 1, lines 50-55.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine teachings of '397 with '073. One of the ordinary skill in the art would have been motivated to modify this combination to receive the non footnote body data and the footnote body data are received in an extensible stylesheets language format to enabling user to *display more than one region, on the same page or on different pages within a title, may use the same style sheet. A title may also contain more than one style sheet, and the publisher is free to associate each display region on the page with any particular style sheet in the*

title. Additionally, style sheets can be shared between titles. Important benefits derived from this invention include efficient delivery and personalization of the published title, see '073 col.1, lines 20-27.

In regard to dependent claim 8, '397 does not explicitly teach, "rendering the non footnote body data and the footnote body data to an alternative format prior to insertion within the media" however '073 teaches, display regions in a page do not contain any text at the time the style sheet is applied. Rather, the text is poured into the region when the title is displayed (also termed rendered) on the customer's computer, see '073 col. 1, lines 15-20.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine teachings of '397 with '073. One of the ordinary skill in the art would have been motivated to modify this combination to rendering the non footnote body data and the footnote body data to an alternative format prior to insertion within the media to enabling user to *display more than one region, on the same page or on different pages within a title, may use the same style sheet. A title may also contain more than one style sheet, and the publisher is free to associate each display region on the page with any particular style sheet in the title. Additionally, style sheets can be shared between titles. Important benefits derived from this invention include efficient delivery and personalization of the published title, see '073 col.1, lines 20-27.*

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Repass et al.	U.S. Patent No. 4,648,067	issued	03-1987
Nurse et al.	U.S. Patent No. 5,097,418	issued	03-1992
Zellweger et al.	U.S. Patent No. 6,230,170	issued	05-2001

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quoc A. Tran whose telephone number is (703) 305-8781. The examiner can normally be reached on Monday through Friday from 9:00AM to 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H. Feild can be reached on (703) 305-9792. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Quoc A. Tran
Patent Examiner
Technology Center 2176
February 6, 2004



JOSEPH FEILD
SUPERVISORY PATENT EXAMINER